

REMARKS

Claims 12, 14, 15, 16, 22 and 25 are canceled, without prejudice. Claims 13, 17, 18, 24 and 27 are amended.

Claim 13 is amended to recite that the outermost layer of the cover is made of the claimed golf ball material. Claim 13 has also been amended to recite that the amount of fatty acid or fatty acid derivative is 5 to 20 parts by weight. Support for the amendment can be found, for example, on page 9, lines 29-30, and on page 15, lines 22-37.

Claim 17 is amended to be in independent form and recite the subject matter of canceled Claim 16. Claim 18 is amended to depend from Claim 13. Claims 24 and 27 are amended to depend from Claim 17.

Upon entry of the amendment, Claims 13, 17, 18, 23-24 and 26-27 will be all the claims pending in the application.

In the Office Action dated November 10, 2004, Claim 17 was objected to as being dependent upon a rejected base claim and Claims 12-16, 18 and 22-27 were rejected under 35 U.S.C. § 103.

At page 2 of the Office Action, Claims 12, 13, 15, 16 and 18-27 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Statz '188 in view Sullivan '831.

Applicants respectfully submit that Claims 12, 13, 15, 16 and 18-27 are not taught, suggested or rendered obvious by the teachings of Statz '188 in view Sullivan '831.

With respect to the rejection of Claims 12, 15, 16, 19-22 and 25, Applicants note that the rejection of these claims is now moot. Further, Applicants submit that the rejection of Claims 24 and 27 should be withdrawn since these claims depend from allowable Claim 17.

Turning to the rejection of Claims 13, 18, 23 and 26, Applicants submit that the combination Statz '188 and Sullivan '831 fails to teach or suggest all of the elements for each of these claims.

The present invention, as recited in independent Claim 13, is directed to a multi-piece golf ball having a cover of at least one layer wherein the outermost layer is formed from a golf ball material comprising a heated mixture that consists essentially of components (A), (B) and (C). *See* Claim 13. Applicants note that the material that is used for the outermost cover layer has good thermal stability, flow characteristics and moldability, and, thus, provides high-performance golf balls with outstanding rebound.

In rejecting Claims 13, 18, 23 and 26, the Examiner relies on Statz '188 as teaching blends of ethylene/acid or ethylene/acid/acrylate copolymer, organic acid, thermoplastic elastomer and a cation source as the material for a one-piece golf ball or as the materials for a core or mantle of a multi-piece golf ball. Sullivan '831 is relied upon as disclosing possible cation sources for neutralizing ionomers.

Applicants submit, however, that Statz '188 does not disclose that the composition described therein is used as the outermost layer of a golf ball cover. As indicated above, the teachings of Statz '188 are limited to the use of the described materials as golf ball cores or

mantles, *i.e.*, an intermediate layer. Applicants respectfully point out that an intermediate layer is quite different from the an outermost layer of a cover.

Applicants additionally submit that it is the use of the claimed material in the outermost layer of the cover that greatly contributes to the superior qualities of the claimed golf ball. Furthermore, these qualities could not have been expected based on the teachings of the prior art since the requirements of the material for a cover (*i.e.*, outer layer) are different from that of a material for a core or an intermediate layer. For example, if the compatibility of the material is lowered, the surface of the golf ball will be rough and the appearance of the golf ball will deteriorate. Also, if the polymer bond power is lowered, the scuffing resistance of the ball will decrease each time the ball is struck. Additionally, if melting viscosity and heat resistance are lowered, the adhesion of the paint will decrease and the appearance of the golf ball will deteriorate.

Applicants further submit that the teachings of Sullivan '831 fail to remedy the shortcomings Statz '188 since Sullivan '831 fails to teach and suggest using the claimed material as the outermost layer of a golf ball.

In view of the foregoing, Applicants respectfully submit that the claim rejections over Statz '188 in view Sullivan '831 be reconsidered and withdrawn.

At pages 2-3 of the Office Action, Claims 12-15, 22 and 23 are been rejected under 35 U.S.C. § 103(a) as obvious over Chen '321 in view of Sullivan '831

Applicants respectfully submit that Claims 12-15, 22 and 23 are not taught, suggested or rendered obvious by the teachings of Chen '321 in view Sullivan '831.

With respect to the rejection of Claims 12, 14, 15 and 22, Applicants note that the rejection of these canceled claims is now moot.

Turning to the rejection of Claims 13 and 23, Applicants submit that the combination of Chen ‘321 and Sullivan ‘831 fails to teach or suggest all of the elements for each of these claims. More specifically, Applicants submit that the prior art “teaches away” from the presently claimed invention.

Chen ‘321 teaches using stearic acid or metal stearates. These compounds are “weak bases” and, as such, their ability to neutralize components (A) and (B) is insufficient or small. Conversely, the present invention employs a basic inorganic metal compound. This type of compound is a “strong base” that is easily capable of neutralizing the acidic groups in components (A) and (B).

Applicants submit that since the claimed basic inorganic metal compound easily neutralizes components (A) and (B), the number of cross-linking points increases and enhances the rebound of a golf ball. Applicants additionally submit that the unexpectedly superior rebound properties of the claimed golf ball are accomplished, in part, by the positioning of the claimed material as the outermost layer of the cover.

Applicants further assert that the teachings of Sullivan ‘831 fail to remedy the shortcomings Chen ‘321. Specifically, Sullivan ‘831 does not suggest that using the claimed material as the outermost layer of a golf ball would result in superior rebound properties.

In view of the foregoing, Applicants respectfully submit that the claim rejections over Chen ‘321 in view Sullivan ‘831 be reconsidered and withdrawn.

At pages 3-4, Claims 12-15, 19, 20, 22 and 23 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Chen ‘321 in view of Statz ‘188 in further view of Sullivan ‘831.

Applicants respectfully submit that Claims 12-15, 19, 22 and 23 are not taught, suggested or rendered obvious by the teachings of Chen ‘321 in view of Statz ‘188, and further in view Sullivan ‘831.

With respect to the rejection of Claims 12, 14, 15, 16, 19 and 22, Applicants note that the rejection of these canceled claims is now moot.

Turning to the rejection of Claims 13 and 23, Applicants submit that the cited prior art does not render the claimed invention obvious for essentially the same reasons that Statz ‘188, in view of Sullivan ‘831, and Chen ‘321, also in view of Sullivan ‘831, fail to render the claimed invention obvious.

As discussed above, neither Sullivan ‘831 nor Statz ‘188 suggest using the presently claimed material in the outermost layer of a golf ball cover. In addition, neither Sullivan ‘831 nor Chen ‘321 suggest using the claimed basic inorganic metal compounds, *i.e.*, the “strong base.”

Further, in order to arrive at the present invention, the Examiner must pick and choose elements from different references in order to make his rejection. Applicants respectfully submit that one cannot pick and choose among individual parts of assorted prior art references “as a mosaic to recreate a facsimile of the claimed invention.” *See Akzo N.V. v. U.S. International Trade Commission*, 1 USPQ 2d 1241, 1246 (Fed. Cir. 1986, citations omitted).

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/695,140

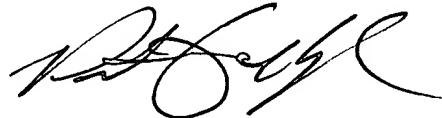
Attorney Docket Q61468

Applicants additionally submit that the improved characteristics of the present invention would not have been expected by one of ordinary skill in the art based on the teachings of the cited prior art. As discussed above, the material that is used for the outermost cover layer has unexpectedly good thermal stability, flow characteristics and moldability, and, thus, provides high-performance golf balls with outstanding rebound.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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